# UNITED STATES PATENT AND TRADEMARK OFFICE

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 09/771,689 | 01/30/2001 | Haruhisa Sakuma | 122.1433 | 8149 |

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| EXAMINER |
|---|
| DADA, BEEMNET W |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2135 | |

DATE MAILED: 12/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | Application No. | Applicant(s) |
|---|---|---|
| **Office Action Summary** | 09/771,689 | SAKUMA ET AL. |
| | Examiner | Art Unit | |
| | Beemnet W. Dada | 2135 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *26 September 2005*.
2a)☐ This action is **FINAL**.    2b)☒ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-30* is/are pending in the application.
　　4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) *1-30* is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.
10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.
　　Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
　　Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
　　a)☐ All  b)☐ Some * c)☐ None of:
　　　　1.☐ Certified copies of the priority documents have been received.
　　　　2.☐ Certified copies of the priority documents have been received in Application No. _____.
　　　　3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
　　* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)☐ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
　　Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
　　Paper No(s)/Mail Date. _____ .
5)☐ Notice of Informal Patent Application (PTO-152)
6)☐ Other: _____.

## DETAILED ACTION

1.      The request filed 26 September 2005 for a request for Continued Examination (RCE)

under 37 CFR 1.114 based on parent Application 09/771,689 is acceptable and an RCE has

been established. Claims 1, 14 and 23 have been amended. Claims 1-30 are pending.

## *Claim Rejections - 35 USC § 103*

2.      The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

3.      Claims 1-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clark US

Patent 4,636,622 in view of Urano et al (hereinafter Urano) US Patent No. 6,202,158.

4.      As per claims 1, 14 and 23, Clark teaches an electronic apparatus comprising;

an identification system wherein user authentication is performed at a computer station

based on stored credentials and if the authentication fails (i.e., condition of stored parameter for

illegal use are established) a photographing device is activated and a photograph of the

unauthorized user is taken and recorded (i.e., stored in a memory), and later the user will be

identified based on at least the recorded photograph [column 2, lines 5-11, 47-61 and column 3,

lines 18-31, 39-46]. Clark teaches a remote memory for storing image information, however

Clark is silent on a memory attached to said apparatus. It would have been obvious to one

having ordinary skill in the art at the time of applicant's invention was made to modify Clark so

that the memory would be attached to said apparatus, since it has been held that rearranging

parts of an invention involves only routine skill in the art. *In Re Japikse,* 86 USPQ 70. Clark is

silent on a first memory provided in said apparatus and a second memory attached to said

apparatus. However, within the same field of endeavor Urano teaches an apparatus including a

first memory, provided in said apparatus having stored therein a parameter for representing at

least conditions of an illegal use of said apparatus (storing in a managing computer illegal

access judgment standard) [column 3, lines 60-65, column 4, lines 1-12, lines 53-62 and column

6, lines 1-15], and a control unit which stores in a second memory illegal access information of

the user and user system when said conditions represented by said parameter are established

[column 4, lines 55-67 and column 6, lines 30-67]. It would have been obvious to one having

ordinary skill in the art at the time the invention was made to modify the teachings of Urano

within the system of Clark because the modification simplifies detection of unauthorized user

and further enhances security of the system.


5.      As per claim 2 and 15, the combination of Urano and Clark teaches the apparatus as

applied above. Furthermore, Urano teaches controlling output of illegal access information

stored in the memory in accordance with an output direction [column 9, lines 57-67 and column

10, lines 1-5].


6.      As per claims 3, 16 and 24, the combination of Urano and Clark teaches the apparatus

as applied above. Furthermore, Urano teaches said control unit directs a set up program to read

out said parameter in said first memory and to record illegal access information in said second

memory [column 4, lines 55-67 and column 6, lines 30-67].


7.      As per claims 4, 17 and 25, the combination of Urano and Clark teaches the apparatus

as applied above. Furthermore, Urano teaches said control unit directs an application program

running on said apparatus to set and alter said parameter in said first memory via an interface prepared on a program [column 5, lines 24-39].

8.      As per claims 5, 18 and 26, the combination of Urano and Clark teaches the apparatus as applied above. Furthermore, Urano teaches said control unit directs the program to output illegal access information [column 9, lines 57-67 and column 10, lines 1-5].

9.      As per claim 6, the combination of Urano and Clark teaches the apparatus as applied above. Furthermore, Urano teaches the apparatus wherein as said parameter recording timing representing conditions for obtaining image information is selected, set and stored in said first memory [column 7, lines 3-25 and lines 50-63].

10.     As per claim 7, 19 and 27, the combination of Urano and Clark teaches the apparatus as applied above. Furthermore, Urano teaches the apparatus wherein illegal access information data management header, a recording time, a recording timing, a recording format and illegal access information data are recorded in said second memory [column 7, lines 3-25 and lines 50-63].

11.     As per claims 8-10, 20 and 28, the combination of Urano and Clark teaches the apparatus as applied above. Furthermore, Urano teaches the apparatus wherein said recording timing of said illegal access information takes place when the power supply for said apparatus is turned on, program is activated, or operation is resumed (i.e., during log-in operations) [column 2, lines 27-32].

12.    As per claim 11, the combination of Urano and Clark teaches the method as applied

above. Furthermore, Urano teaches the apparatus wherein said recording timing of illegal

access information takes place when an illegal password is entered in said apparatus [column

6, lines 1-15].


13.    As per claims 12, 21 and 29, the combination of Urano and Clark teaches the apparatus

as applied above. Furthermore, Urano teaches the apparatus wherein information acquiring

format and writing mode are selected, set and stored in said first memory as said parameter

[column 7, lines 28-43].


14.    As per claims 13, 22 and 30 the combination of Urano and Clark teaches the method as

applied above. Furthermore, Urano teaches the apparatus wherein the mode of writing illegal

access information into second memory is overwriting or an appending mode [column 5, lines

50-61].

### Response to Arguments

Applicant's arguments filed September 26, 2005 have been fully considered but they are

not persuasive. Applicant argues that Clark does not have a memory attached to the apparatus

to store the acquired image information of the user using the apparatus, and display of the

apparatus to display the image information as recited in the claims. Examiner disagrees.

Examiner would point out that Clark teaches an apparatus including a method wherein a

photographing device is activated and a photograph of the unauthorized user is taken and

recorded (i.e., stored in a remote memory), and later the user will be identified based on at least

the recorded photograph [column 2, lines 5-11, 47-61 and column 3, lines 18-31, 39-46]. Clark

teaches a remote memory for storing image information. However, One having ordinary skill in

the art at would have been able to modify Clark so that the memory would be attached to said

apparatus, since it has been held that rearranging parts of an invention involves only routine

skill in the art. *In Re Japikse*, 86 USPQ 70. Examiner asserts that the combination of Clark and

Urano teaches the apparatus as discussed above and therefore the rejection is respectfully

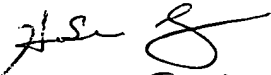maintained.

## *Conclusion*

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Beemnet W. Dada whose telephone number is (571)

272-3847. The examiner can normally be reached on Monday - Friday (9:00 am - 5:30

pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Kim Y. Vu can be reached on (571) 272-3859. The fax phone number for

the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

Beemnet Dada

December 5, 2005

*Primary Examiner*

*Art Unit 2135*